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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Scott Montgomery

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ORRICK, HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT

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EXAMINER

OBEID, MAMON A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/990,605	Applicant(s) MONTGOMERY ET AL.	
	Examiner MAMON OBEID	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 157- 167 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 157- 167 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Acknowledgements

1. This case has been transferred to the Examiner of record. All prior office actions are incorporated herein by reference.
2. This communication is in response to the claim amendment filed April 21, 2008 and further in response to the telephone interview on April 21, 2008 ("Telephone Interview"). In the Telephone Interview, Applicants representative, Mark Stirrat, pointed out that the office action mailed on December 20, 2007 ("First Non-final Office Action") does not clearly map the claim limitations to the Moore reference. After a further review of the First Non-Final Office Action and the Moore reference and for the sake of clarity, The Examiner issues herein a Second Non-final Office Action.
3. Claims 157 and 160 have been amended.
4. Claims 1-156 were previously canceled.
5. Claims 157-167 are pending and presented for examination.

Claim Objections (Drawings)

6. The drawings are objected to under 37 CFR 1.83(a) because they are incomplete. 37 C.F.R. §1.83(a) reads as follows:

The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box). In addition, tables and sequence listings that are included in the specification are, except for applications filed under 35 U.S.C. 371, not permitted to be included in the drawing.

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7. The Applicant is requested to submit the necessary drawings that illustrate the claimed invention (e.g., from claim 157 "postal authority" is not illustrated).

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 157-167, as best understood by the Examiner, are rejected under 35 U.S.C. §101 because the claims are considered hybrid claims. See MPEP §2173.05(p)

II. If Applicants overcome the related 35 U.S.C. §112 2nd paragraph rejection below, this particular 35 U.S.C. §101 rejection will be withdrawn.

Claim Rejections - 35 U.S.C. §112 2nd Paragraph

10. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 157-167 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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12. Claims 157- 167 are indefinite because the claims are considered hybrid claims. See MPEP §2173.05(p) II. In particular, the claims are directed to neither a “process” or a “machine” but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C §101.

13. For example, claim 157 begins "A postage indicia generation system for implementation with a postal system comprising. . . ." In light of this evidence, the Examiner interprets these recitations as express intent by Applicants to claim a *product* claim.

14. Claim 157 however, continues with "a vendor controlled centralized postage-issuing computer system accessible to a plurality of of end user computers, configured to...." followed by a series of seven (7) method steps:

- i. generate a unique postage indicium upon request by the end user computer;
- ii. communicate with a centralized master tracking computer system
- iii. receive a unique tracking identification string generated by the centralized master tracking computer system for application to a mail piece such that the tracking identification string is readable independent of the indicium,

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- iv. associate the tracking identification string with the unique postage indicium,
- v. store the association in a database and transmit both the unique tracking identification string and the unique postage indicium to the end user computer,
- vi. enable a postal authority to verify postage on the mail piece by transmittal of the tracking identification string to the centralized postage-issuing computer system
- vii. upon receipt of the tracking identification string from the postal authority, retrieve the unique postage indicium from the database and transmit data corresponding to the unique postage indicium to the postal authority.

15. In light of Applicants' recitation of no less than seven (7) method steps, the Examiner interprets these particular recitations of method steps as express intent by Applicants to claim a *process* claim.

16. In light of the conflicting evidence noted above, claim 157 could reasonably be drawn to either a product or process. In accordance with §2173.05(p) II. which states that a single claim must be drawn to either a product or process (but not both) and because a competitor of Applicants would not know whether *possession* of the claimed

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structure constituted infringement, or alternatively, if infringement required the *execution* of the recited seven (7) method steps, the claims are indefinite. If Applicants overcome this particular 35 U.S.C. §112, 2nd paragraph rejection, the related 35 U.S.C. §101 rejection will also be withdrawn. For examination purposes, the Examiner will interpret claims 157-167 as claims directed to a product only.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 157-167 are rejected under 35 U.S.C. 103(a) as being anticipated by U.S. Patent No. 5917,925 ("Moore") in view of Gordon et al, U.S. Patent No. 6,527,178 B1 ("Gordon").

19. **As per claims 157 and 160:** Moore clearly teaches a postage indicia generation system for implementation with a postal system, comprising;

a. a *vendor controlled* centralized postage-issuing computer system ("control computer **12**") accessible to a plurality of end user computers (e.g. "host computers **14**"), configured to generate and transmit a unique postage indicium

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(“indicia”, mark or symbol) to an end user computer upon request by the end user computer (column 10, lines 1- 64); figure 1 and related text).

b. wherein the centralized postage-issuing computer system is configured to communicate with a centralized master tracking computer system (“vendor **12**”) and to receive a unique tracking identification string generated by the centralized master tracking computer system for application to a mail piece such that the tracking identification string is readable independent of the indicium (column 10, lines 1-24, column 14, lines 15-67),

c. further wherein the centralized postage-issuing computer system is configured to associate the tracking identification string with the unique postage indicium, store the association in a database *and transmit both the unique tracking identification string and the unique postage indicium to the end user computer* (column 6, lines 15- 31).

d. further wherein the centralized postage-issuing computer system is configured to enable a postal authority to verify postage on the mail piece by *transmittal* of the tracking identification string to the centralized postage-issuing computer system (column 4, lines 26- 46; column 12, lines 25- 43).

e. the centralized postage-issuing computer is configured to, upon receipt of the tracking identification string from the postal authority, retrieve the unique postage indicium from the database and transmit data corresponding to the

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unique postage indicium to the postal authority (column 4, lines 26- 46; column 12, lines 25- 43).

20. Moore further discloses monitoring the flow of mailpieces through a postal processing and delivery system including generating a unique pattern comprising an encoded input data entry stored on a mass storage device accessible by a CPU where the input data comprises one or more of a unique postal service identifiers, a unique customer identifier, a unique point of mailing identifier, a unique destination identifier, a unique postage amount, an unique mailpiece weight, and time and date information and where the encoded data entry comprises a digital encoding of the input data (column 8, lines 1- 10).

21. Moore further discloses marked mailpieces enter the postal processing and distribution system. At one or more point in the processing and distribution system, an on-site or "field" reader captures or "reads" the mark and decodes the mark to preferably an ASCII string. The field reader then transmits the ASCII string to the control computer and to the appropriate customer host computer, wherein the mark is compared with marks residing in a database in the control computer and compared with a lesser, customer specific database residing in the customer's host computer. An authenticating match, and authentication of other data contained in the mark such as the identifier of an authorized customer, may or may not be obtained from the

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comparison. Results of these comparisons are then transmitted back to the field reader and displayed preferably in clear text. This allows the postal processor to immediately identify counterfeit mailpiece indicia marks, or to identify the use of authentic indicia marks by unauthorized personnel, or identify the use of authorized indicia without proper fee payment, or to identify improperly distributed mailpieces, or to obtain additional information on the inspected mailpiece (column 4, lines 26- 46).

22. Moore does not expressly disclose wherein the centralized postage-issuing computer system is configured to communicate with a centralized master tracking computer system and to receive a unique tracking identification string generated by the centralized master tracking computer system for application to a mail piece such that the tracking identification string is readable independent of the indicium.

23. Gordon, however, discloses a postal authority **10** connected to master log database **20**. Gordon further discloses an indicia including serial or transaction number; Wherein the postal authority associate the generated indicia with the recipient address in indexed fashion within the log database for later authentication (column 5, lines 20- 33). Gordon in another aspect of the invention, discloses a third-party server **22** which operates as a distribution entity for the postage indicia, generating a postage indicia and associate said indicia with the recipient address in indexed fashion within the log database for later authentication (column 5, lines 44- 57; column 6, lines 7- 21).

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24. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Moore's teachings to include a centralized master tracking computer that generates a postage indicia including a serial or transaction number to be transmitted to the centralized postage-issuing computer system as disclosed by Gordon, to enable the postal authority to identify counterfeit postage indicia and therefore preventing postage counterfeiting (Gordon: column 1, lines 53- column 2, line13).

25. **As per claims 158, 163 and 166:** Moore further discloses wherein the unique tracking identification string on the mail piece is represented as a one-dimensional barcode, and wherein the centralized postage-issuing computer system is configured to enable the postal authority to request the unique postage indicium by submission of data derived from the one-dimensional barcode (column 16, lines 31- 42).

26. **As per claims 159, 164 and 167:** Moore further discloses the use of digital signature for authenticating postage indicium but does not specifically disclose wherein the unique postage indicium is associated with a digital signature not applied to the mail piece. However, Gordon discloses a digital signature that is associated with a postage indicia. Gordon further discloses that the digital signature may be omitted and hence not applied to the postage indicia (column 9, lines 50- 65). Gordon further discloses

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associating a postage indicium with a recipient address in a master log file, wherein the recipient address is not included in the postage indicia (see abstract).

27. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Moore teachings to reduce the information included in the postage indicia as disclosed by Gordon to reduces the physical size of the required indicia, allowing additional real estate on the face of a mailpiece to be utilized for advertising verbiage, graphics, personal messages, illustrations, etc (Gordon: see abstract; column 2, lines 3- 13).

28. **As per claim 161:** Moore further discloses wherein the centralized postage-issuing computer is configured to, upon validation of the unique postage indicium, send the unique postage indicium to the postal authority for further validation (column 4, lines 26- 46).

29. **As per claims 162 and 165:** Moore further discloses wherein the centralized master tracking computer system is operated by the postal authority (column 10, lines 1- 24).

30. The Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the

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specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Response to Arguments

31. Applicant's arguments with respect to claim 157 and 160 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mamon Obeid whose telephone number is (571) 270-1813. The examiner can normally be reached on Mon-Fri 9:30 AM- 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mamon Obeid
Examiner
Art Unit: 3621
August 21, 2008

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621